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Supreme Court, U.S.
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No. 03-1422

IN THE

Supreme Court of the United States

ANTHONY J. DEGIDIO,

Petitioner,

v.

WEST GROUP CORPORATION; THE THOMSON CORPORATION; WEST LICENSING CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the United States Court of Appeals for the Sixth Circuit applied the appropriate standard of review in passing on the judgment of the United States District Court for the Northern District of Ohio.

PARTIES TO THE PROCEEDING

Respondents are satisfied with Petitioner's description of the parties to the proceeding except as follows: West Group is a "d/b/a" of West Publishing Corporation, with its principal place of business in Eagan, Minnesota. The Thomson Corporation is the ultimate parent of West Publishing Corporation.

CORPORATE DISCLOSURE STATEMENT

The following are parent corporations or publicly held companies that own ten percent or more of West Group's stock:

The Thomson Corporation;
Thomson Canada Limited;
Thomson U.S. Holdings Inc.;
Thomson Corporation U.S.A. Inc.;
Thomcorp. No. 4 Inc.;
Thomcorp. No. 5 Inc.;
THI (U.S.) Inc.;
Thomson U.S. Inc.;
The Thomson Corporation Delaware Inc.;
Thomson Healthcare Inc.;
Thomson Financial Inc.; and
Thomson Legal & Regulatory Inc.

There is no parent or publicly held company owning ten percent or more of The Thomson Corporation's stock.

West Licensing Corporation recently merged into West Publishing Corporation. The following are parent corporations or publicly held companies that own ten percent or more of West Publishing Corporation's stock:

The Thomson Corporation;
Thomson Canada Limited;
Thomson U.S. Holdings Inc.;
Thomson Corporation U.S.A. Inc.;
Thomcorp. No. 4 Inc.;
Thomcorp. No. 5 Inc.;
THI (U.S.) Inc.;
Thomson U.S. Inc.;
The Thomson Corporation Delaware Inc.;
Thomson Healthcare Inc.;
Thomson Financial Inc.; and
Thomson Legal & Regulatory Inc.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDING	ii
CORPORATE DISCLOSURE STATEMENT	ii
TABLE OF CONTENTS	iv
TABLE OF CITED AUTHORITIES	v
STATEMENT OF THE CASE	1
District Court Proceedings	1
Petitioner's Activities	2
Respondents' Business	3
Third-Party Uses of "Lawoffice"	4
Court of Appeals Proceedings	5
SUMMARY OF THE ARGUMENT	6
THE ARGUMENT	6
CONCLUSION	10

TABLE OF CITED AUTHORITIES

CASES *Page*

Agosto v. I.N.S., 436 U.S. 748 (1978) 6

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986) 5, 7

Brown v. Crawford, 906 F.2d 667 (11th Cir. 1990) .. 6

Icicle Seafoods, Inc. v. Worthington, 475 U.S. 709 (1986) 6, 8, 9

Jarrett v. Norfolk Redevelopment & Hous. Auth., 74 F. Supp. 585 (E.D. Va. 1947), *aff'd*, 169 F.2d 409 (4th Cir. 1948) 10

Rosen v. Bezner, 996 F.2d 1527 (3d Cir. 1993) 9

Siegal v. Fed. Home Loan Mortgage Co., 143 F.3d 525 (9th Cir. 1998) 7

Spannaus v. United States Dep't of Justice, 813 F.2d 1285 (4th Cir. 1987) 9

Terry Barr Sales Agency, Inc. v. All-Lock Co., Inc., 96 F.3d 174 (6th Cir. 1996) 5

United States ex rel. Indus. Instrument Corp. v. Paul Hardeman, Inc., 320 F.2d 115 (5th Cir. 1963) .. 10

Cited Authorities

Page

Vieux v. E. Bay Regional Park Dist., 906 F.2d 1330 (9th Cir. 1990) 6

Williams v. Widnall, 79 F.3d 1003 (10th Cir. 1996) .. 6

Wooden v. Bd. of Regents of Univ. Sys. of Ga., 247 F.3d 1262 (11th Cir. 2001) 9

STATUTES

15 U.S.C. § 1121(a) 1

28 U.S.C. § 1331 1

28 U.S.C. § 1338(a) 1

28 U.S.C. § 1338(b) 1

28 U.S.C. § 1367(a) 1

RULES

Fed. R. Civ. P. 52(a) 6, 8

Fed. R. Civ. P. 56(c) ..... *passim*

STATEMENT OF THE CASE

District Court Proceedings

Petitioner filed this lawsuit in the United States District Court for the Northern District of Ohio (the "District Court") on August 24, 1999, asserting seven causes of action under federal and Ohio law for trademark infringement, unfair competition, dilution and misappropriation, all of which involve the same basic and undisputed facts. The District Court had jurisdiction over these causes of action pursuant to 15 U.S.C. § 1121(a) and 28 U.S.C. §§ 1331, 1338(a), 1338(b) and 1367(a).

On May 31, 2001, Respondents moved for summary judgment on each of Petitioner's seven causes of action. On June 28, 2001, Petitioner cross-moved for summary judgment on four of his causes of action concerning unfair competition and trademark infringement.

On March 18, 2002, in a memorandum opinion, the District Court granted Respondents' motion for summary judgment on six of the seven causes of action and denied Petitioner's motion for summary judgment.[1] (*See generally* App. 19-48.)

The District Court identified the following undisputed facts:

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1. As to the single remaining cause of action, common law misappropriation, the District Court granted Respondents' renewed motion for summary judgment on May 23, 2002.

Petitioner's Activities

In 1996 (App. 36), Petitioner, a lawyer whose "practice is focused on cyberlaw and intellectual property issues" (App. 33), registered the domain name <lawoffices.net> (App. 20). Petitioner began using the LawOffices.net designation in connection with an Internet Web site, "which provides an attorney directory, legal information relating to cyberlaw issues, a vanity email service, listings of domain names for sale, and a hosting service for legal related websites." (App. 20.)

Petitioner "does not own either a federal or state registration for the LawOffices.net designation." (App. 20.) "The essential features of [Petitioner's] putative trademark are: (1) a capitalization of the letters 'l' and 'o;' (2) pluralization of 'lawoffice;' and (3) placement of the term 'LawOffices.net' in black font in a horizontal rectangular box that is shaded in marbled white and light gray." (App. 20.) Petitioner's mark appears on the Web site located at www.lawoffices.net as follows:

. (App. 46.)

Petitioner "has spent $2,500 over four years to advertise and promote his website." (App. 38.) Petitioner "has not engaged in direct mail, print, radio or television advertising of the LawOffices.net Web site." (App. 38.) "While [Petitioner] has spent $2,500 on advertising, he does not establish that these expenditures are extensive, nor that the expenditures are beyond that necessary for market survival." (App. 38.)

Petitioner "has earned no revenue from services he provides through his website, . . . he has never had a paying customer, has never had any employees, and has earned less than $ 200 in revenue from banner advertisements and click-through revenues." (App. 39.)

Petitioner "offers the affidavits from three people who have accessed the lawoffices.net website, but provides no further evidence of a customer base." (App. 39; *accord* App. 35.) Petitioner "does not offer testimony from a single customer who states that he associates LawOffices.net solely with [Petitioner] or that he visited the lawoffices.net website because he identified the moniker with a particular source of services." (App. 35-36.)

Respondents' Business

In 1999, Respondents "considered 'a variety of existing and potential Internet domain names as candidates for re-naming and expanding the services then offered through the West Legal Directory Web site,' located at www.wld.com." (App. 40.) Respondents "selected the lawoffice.com domain name and mark because they 'more readily conveyed to consumers the nature of the legal information and services offered by [Respondents].'" (App. 40.)

In June 1999 (App. 37), Respondents started using "the designation Lawoffice.com and the domain name 'lawoffice.com' to market . . . [an] online resource for useful information pertaining to law and lawyers for businesses, professional[s] and consumers.'" (App. 20-21.) Respondents' "website offers information on over four hundred legal topics, a directory of attorneys and other legal professionals, an online searchable legal dictionary, and a frequently asked

questions section." (App. 21.) "In addition to the aforementioned services, [Respondents] also offer[] fee-based services, including email, website creation and hosting, and sponsorship packages." (App. 21.) "However, these fee-based services are not advertised at the Lawoffice.com website." (App. 21.)

> The essential features of the designation Lawoffice.com are: (1) capitalization of the letter 'l;' (2) singular, as opposed to plural, 'lawoffice;' (3) italicization of 'law;' (4) placement of Lawoffice.com in white font in a dark blue rectangular box; (5) a multi-colored open door emblem situated over the 'dot;' and (6) the text 'from West Legal Directory' placed in smaller white font beneath Lawoffice.

(App. 21.) "Lawoffice.com is redirected to a FindLaw directory page at http://directory.findlaw.com." (App. 46.) "The disputed mark no longer appears on [Respondents'] website." (App. 46.) "However, until recently, [Respondents'] mark appeared on the website lawoffice.com as follows:

." (App. 46.)

Third-Party Uses of "Lawoffice"

"[O]thers obviously have utilized permutations of LawOffices.net in order to represent their own suite of legal services." (App. 33.) "Both sides have submitted information, including telephone directory listings and website search engine results, indicating that there are numerous organizations and websites utilizing the term 'lawoffice' to represent their business." (App. 37.)

Based on these undisputed facts, the District Court held that "[Petitioner's] mark is not entitled to [trademark] protection because it is descriptive and devoid of secondary meaning." (App. 26.) Therefore, the District Court granted summary judgment to Respondents and against Petitioner on his causes of action for trademark infringement, unfair competition and dilution. (App. 41.)

Court of Appeals Proceedings

On June 22, 2002, Petitioner filed a notice of appeal in the United States Court of Appeals for the Sixth Circuit ("Court of Appeals"). Petitioner claimed that the District Court erred "when it determined that his mark LAWOFFICES, was descriptive and that it had not acquired secondary meaning." (App. 2.)

The Court of Appeals reviewed the District Court's "grant of summary judgment de novo." (App. 3.) Thus, in reviewing the District Court's grant of summary judgment, the Court of Appeals applied the same standard that was employed by the District Court initially under Federal Rule of Civil Procedure 56(c). (App. 3 (citing *Terry Barr Sales Agency, Inc. v. All-Lock Co., Inc.*, 96 F.3d 174, 178 (6th Cir. 1996).) The Court of Appeals stated that "[s]ummary judgment is appropriate where 'there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law.'" (App. 3 (citing Fed. R. Civ. P. 56(c).)

The Court of Appeals "view[ed] the evidence and dr[e]w all 'justifiable inferences' in the light most favorable to" Petitioner. (App. 3 (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).) Affirming the District Court's

decision, the Court of Appeals agreed that Respondents were entitled to judgment as a matter of law because Petitioner's putative trademark LAWOFFICES was descriptive and had not acquired secondary meaning. (App. 2.)

SUMMARY OF THE ARGUMENT

It is well established that the proper standard of review of a trial court's order granting summary judgment is *de novo*. Thus, the Court of Appeals relied on well-established precedent when it applied a *de novo* standard of review to the District Court's order granting summary judgment. Despite this well-established precedent, Petitioner suggests that the Court of Appeals should have set aside findings of fact of the District Court that were "clearly erroneous" within the meaning of Federal Rule of Civil Procedure 52(a). However, Federal Rule of Civil Procedure 52(a) and thus, *Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709 (1986), do not apply to decisions on summary judgment motions.

THE ARGUMENT

There can be no dispute about the proper standard of review of the District Court's order granting Respondents' motion for summary judgment. The Court of Appeals reviews the District Court's grant of summary judgment *de novo*, applying the same legal standards used by the District Court. *See, e.g., Agosto v. I.N.S.*, 436 U.S. 748, 756-57 (1978); *Brown v. Crawford*, 906 F.2d 667, 669 (11th Cir. 1990); *Williams v. Widnall*, 79 F.3d 1003, 1005 (10th Cir. 1996); *Vieux v. E. Bay Regional Park Dist.*, 906 F.2d 1330, 1332 (9th Cir. 1990). "Summary judgment is appropriate where 'there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law.'"

(App. 3 (citing Fed. R. Civ. P. 56(c) (internal quotations omitted).) The Court of Appeals, like the District Court, must view the evidence "in the light most favorable to the nonmoving party," *Siegal v. Fed. Home Loan Mortgage Co.*, 143 F.3d 525, 528 (9th Cir. 1998) and "all justifiable inferences are to be drawn in his favor," *Anderson*, 477 U.S. at 255. Thus, the Court of Appeals performs the same basic and well-settled role as the District Court, that is, as a gatekeeper against factually unsupported claims not worthy of jury consideration.

The Court of Appeals—fulfilling its duty as gatekeeper—followed the proper procedures; it "view[ed] the evidence and dr[e]w all 'justifiable inferences' in the light most favorable to" Petitioner. (App. 3 (citing *Anderson*, 477 U.S. at 255).) In fact, the Court of Appeals noted that "the district court did not necessarily view evidence in light most favorable to [Petitioner] when it applied the six-factor McCarthy test" and determined that Petitioner's putative trademark was descriptive. (App. 9.) The Court of Appeals then correctly "view[ed] the evidence in the light most favorable to [Petitioner]" and found that "the mark LAWOFFICES lies very close to the descriptive end of the continuum." (App. 9.) Because the Court of Appeals found that Petitioner's LAWOFFICES putative trademark was descriptive, it appropriately noted that Petitioner must establish that his putative trademark has acquired secondary meaning. (App. 9-10.) The Court of Appeals viewed the evidence in the light most favorable to Petitioner, applied the seven-factor test used by courts in the Sixth Circuit to determine whether a mark has acquired secondary meaning, and agreed with the District Court that Petitioner had failed to meet his burden of establishing a secondary meaning for his putative trademark. (App. 9-12.)

Despite that well-established precedent states that reviewing courts employ a *de novo* standard in reviewing decisions on summary judgment, Petitioner suggests that the Court of Appeals should have set aside findings of fact of the District Court that were "clearly erroneous" within the meaning of Federal Rule of Civil Procedure 52(a). (Pet. at 5.) However, Rule 52(a) specifically states that "[f]indings of fact . . . are unnecessary on decisions on motions under Rules 12 or 56." Thus, Petitioner's claim that the Court of Appeals must be bound by Federal Rule of Civil Procedure 52(a) and, by extension, this Court's decision in *Icicle Seafoods*, 475 U.S. 709, is incorrect.

In *Icicle Seafoods*, the district court presided over a two-day bench trial, 475 U.S. at 710, and thus, was required to issue findings of facts under Federal Rule of Civil Procedure 52(a). Fed. R. Civ. P. 52(a) ("In all actions tried upon the facts without a jury . . . , the court shall find the facts specially"). These "[f]indings of fact . . . shall not be set aside unless clearly erroneous." *Id.* While the court of appeals proposed to "review the facts under a clearly erroneous standard . . . nowhere it its opinion did the court ever mention any of the factual findings of the District Court, much less discuss or analyze them." 475 U.S. at 713. Instead, unlike here, the court of appeals improperly "made factual findings on its own."[2] *Id.* at 714. Thus, this Court vacated the

2. Petitioner claims incorrectly that the Court of Appeals "dispensed with the issue" of likelihood of confusion and engaged in improper fact finding regarding this issue. (*See* Pet. at 7.) The passage from the Court of Appeals decision Petitioner quotes specifically addresses the question of "whether 'LAWOFFICES' is a suggestive or a descriptive mark," not the question of likelihood of confusion. (Pet. at 7 (citing App. 9).) Moreover, neither the Court of (Cont'd)

judgment of the court of appeals. *Id.* at 715. Because this case was decided by summary judgment, *Icicle Seafoods* and Federal Rule of Civil Procedure 52(a) do not apply. *See, e.g.*, *Wooden v. Bd. of Regents of Univ. Sys. of Ga.*, 247 F.3d 1262, 1271 n.9 (11th Cir. 2001) ("a district court does not make factual findings in deciding a summary judgment motion, so no question of clear error review even arises here."); *Rosen v. Bezner*, 996 F.2d 1527, 1530 n.2 (3d Cir. 1993) ("because summary judgment may only be granted where there is no genuine issue of material fact, any purported 'factual findings' of the [trial] court cannot be 'factual findings' as to disputed issues of fact, but rather are conclusions as a matter of law that no genuine issue of material fact exists"); *Spannaus v. United States Dep't of Justice*, 813 F.2d 1285, 1288 n.4 (4th Cir. 1987) ("Any findings of fact made on a summary judgment motion, however, are not 'entitled to the protection of the "clearly erroneous" rule on review.'").

In this case, although not required to do so pursuant to Rule 52(a), the District Court issued a memorandum opinion setting forth the undisputed facts supporting its decision. *See* discussion *supra* pages 2-4. The Court of Appeals was thus able to use the District Court's memorandum to aid it in

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(Cont'd)

Appeals nor the District Court addressed the issue of likelihood of confusion—nor were they required to do so—because Petitioner had not satisfied the threshold requirement that his putative mark was entitled to trademark protection. (App. 4 (citing cases) ("As the district court correctly noted, in order to prevail on any of the first six counts, Plaintiff must establish that the designation 'LawOffices.net' is indeed a valid and legally protectable trademark.").) Petitioner himself admits as much. (Pet. at 4 ("*After* determining that there is a mark deserving protection courts consider whether or not there is a likelihood of confusion.") (emphasis added).)

the reviewing process. *See, e.g., United States ex rel. Indus. Instrument Corp. v. Paul Hardeman, Inc.*, 320 F.2d 115, 116 (5th Cir. 1963); *Jarrett v. Norfolk Redevelopment & Hous. Auth.*, 74 F. Supp. 585, 586 (E.D. Va. 1947), *aff'd*, 169 F.2d 409 (4th Cir. 1948). However, ultimately, the role of the Court of Appeals is to determine (i) whether there exists a genuine issue of material fact resolvable only at trial and (ii) whether the moving party is entitled to a judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Court of Appeals did just that. Neither party argued that there existed disputed issues of material fact; in fact, the parties cross-moved for summary judgment. The Court of Appeals decision raises no appropriate issue for review by this Court.

CONCLUSION

Because the Court of Appeals applied the appropriate standard of review in passing on the judgment of the District Court, the Petition should be denied.

Respectfully submitted,

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